

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed October 24, 2006. Claims 16 and 21 are added. Claims 1-21 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. §102(e)

The Examiner rejects claims 1, 2, and 6-15 under 35 U.S.C. § 102(e)¹ as being anticipated by *Ames et al.* (United States Patent Application Publication No. 2003/0085054). Because *Ames* does not teach each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

A claim is anticipated under 35 U.S.C. § 102 (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure* ("MPEP") § 2131.

¹ Because *Ames* is only citable under 35 U.S.C. § 102(e) Applicants do not admit that *Ames* is in fact prior art to the claimed invention but reserve the right to swear behind *Ames* if necessary to remove it as a reference.

According to the Examiner on page 2 of the Office Action, “Ames also discloses the lead frame connector provides mechanical support for the optical sub-assembly; See figures 2 and 8-10, which show that there is no additional support for the optical assembly other than the flex cable, and see the support (66) in figure 9 (p. 3, [0023] and [0027]).”

This characterization of *Ames* is in direct contrast to the teachings of *Ames* which emphasizes throughout that the flex cable 10 is intended only to “electrically couple” the ROSA and TOSA to the transceiver wiring board 32. *See e.g.* paragraph [0012], line 2; paragraph [0039], line 1. There is no teaching or suggestion in *Ames* that the flex cable 10 is used to “mechanically support” the optical subassemblies as is claimed.

Indeed, *Ames* emphasizes that the flex cable 10 is flexible and any stress on the flex cable 10 is prevented. *See* [0041] and [0054]. More specifically, paragraph [0054] clearly indicates that “this configuration prevents stress in the flex cable, and in the respective electrical connections between the leads and the flex cable.” (Emphasis added). Such stress would be present if the flex cable 10 provided mechanical support for the optical subassemblies 14 and 16. Therefore, the flex cable 10 clearly does not provide mechanical support for the optical subassemblies 14 and 16 as alleged, as this would be in direct contrast to this statement of *Ames*. Rather Figures 2 and 8-10 are illustrative perspective views showing the assembly of the optical transceiver assembly, which is common in patent applications as the Examiner knows. To hold otherwise, one would have to assume that the transceiver 12 in Figure 2 is not itself intended to be supported in any fashion.

Moreover, the stiffener plate 66 only provides support for the flex cable at the connection between the flex cable and the transceiver wiring board. *See* Figure 9 and paragraph [0058]. There is simply no support for the assertion that the stiffener plate 66 provides mechanical support for the optical subassemblies 14 and 16. Rather, the stiffener plate 66 merely provides support to “help ensure that the connection between the flex cable and the transceiver wiring board is maintained.” Paragraph [0058] (emphasis added).

A. Rejection Under 35 U.S.C. §103(a)

The Examiner rejects claims 1-4 and 6-15 under 35 U.S.C. § 103(a) as being obvious over *Card* et al. (United States Patent No. 5,295,214) in view of *Ames*. The Examiner also rejects claim 4 under 35 U.S.C. § 103(a) as being obvious over *Ames* in view of *Card*. The

Examiner rejects claim 5 under 35 U.S.C. § 103(a) as being obvious over *Ames* in view of *Liu et al.* (United States Patent Application Publication No. 2003/0026081). The Examiner also rejects claim 5 under 35 U.S.C. § 103(a) as being obvious over *Card* in view of *Ames* in view of *Liu*.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness. If the PTO does not set forth a *prima facie* case of obviousness, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

As discussed above, *Ames* does not teach a lead frame connector which provides mechanical support for an optical sub-assembly. In fact, *Ames* clearly teaches away from such assertion. Rather, *Ames* teaches that stress in the flex cable and in the respective electrical connections between the leads and the flex cable is prevented. Paragraph [0054] (emphasis added). If the flex cable 10 provided mechanical support for the optical subassemblies 14 and 16 stress in the flex cable and in the respective electrical connections between the leads and the flex cable would clearly not be prevented.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, ... would be led in a direction divergent from the path that was taken by the Applicant.” *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). It is well established that references that “references that teach away cannot serve to create a *prima facie* case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed Cir 2001) (emphasis added). As such, a *prima facie* case of obviousness has not been set forth and the rejections of claims 1-15 should be withdrawn at least for the reason that *Ames* teaches away from the proposed combination.

II. NEW CLAIMS

Claims 16-21 are added and depend from claim 1 or 11. As such, claims 16-21 are believed to be allowable at least for the same reasons as claims 1 or 11.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 26th day of March, 2007.

Respectfully submitted,

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